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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,654	08/15/2001	Menno Anne Treffers	NL000448	1920

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EXAMINER.

POPHAM, JEFFREY D

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,654

Applicant(s)

TREFFERS, MENNO A. ET AL.

Examiner

Jeffrey D. Popham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20010815, 20020109</u> | 6) <input checked="" type="checkbox"/> Other: <u>20020214</u> |

Remarks

Claims 1-13 are pending.

Specification

1. The abstract of the disclosure is objected to because below the abstract it says "Fig. 1", which should not be there. Correction is required. See MPEP § 608.01(b).
2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Objections

3. Claims 10 and 11 are objected to under 37 CFR 1.75(a) because of the following informalities:

- Claim 10, line 2 recites the limitation "said recording medium". There is insufficient antecedent basis for this limitation in the claims. For purposes of prior art rejection, it has been construed as "said record carrier".
- Claim 10, lines 1-2: "each track of said record carrier" should be "the record carrier has tracks, and each track".
- Claim 11, line 3 recites the limitation "said recording carrier". There is insufficient antecedent basis for this limitation in the claims. For purposes of prior art rejected, it has been construed as "said record carrier".
- Claim 11, line 4: "a commercial reproducing devices" should be "commercial reproducing devices".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear et al. (U.S. Patent Application Publication 2001 / 0042043) in view of Downs et al. (U.S. Patent 6,226,618) and Ginter et al. (U.S. Patent 5,892,900).

Regarding Claim 1,

Shear et al. disclose a method for controlling distribution and use of a digital work (DW), comprising the steps of:

Attaching a usage right information to said DW, said usage right information defining one or more conditions which must be satisfied in order for said usage right to be exercised (Page 11, Paragraph 169);

Storing said DW and its attached usage right information on a record carrier (Page 11, Paragraph 70);

Refusing the use of said DW if said usage right information indicates that the usage right has been exercised (Page 17, Paragraph 251); and

Characterized in that a hidden information stored in a hidden channel (Page 15, Paragraph 218).

Shear et al. do not disclose updating the usage rights or the hidden information.

Downs et al., however, discloses updating said attached usage right information with every use of said DW (Column 21, lines 42-63). It would have been obvious to one of ordinary skill in the art at the time of

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applicant's invention to incorporate the content delivery system of Downs et al. into the rights protection system of Shear et al. in order to enforce the usage rights on the original copy and any new secondary copy.

Downs et al. do not disclose that the hidden information is changed when usage right information is changed.

Ginter et al., however, disclose that the hidden information is used for encrypting or verifying the usage right information is changed when the usage right information is changed (Column 136, lines 37-42). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the rights protection system of Ginter et al. into the rights protection system of Shear et al. as modified by Downs et al. in order to lessen the time during which each key is used, giving an attacker less ciphertext to use in an attempt to obtain the key (Column 212, lines 43-52).

Regarding Claim 11,

Claim 11 is an apparatus claim that is broader than method claim 1 and is rejected for the same reasons.

Regarding Claim 13,

Claim 13 is an apparatus claim that corresponds to method claim 1 and is rejected for the same reasons.

Regarding Claim 3,

Shear et al. and Downs et al. do not disclose that the key is randomly changed.

Ginter et al., however, disclose that the hidden information is a key (KLK) used for decrypting the usage right information, wherein the key is randomly changed and the usage right information is re-encrypted by using the changed key, when the usage right information has changed (Column 136, lines 37-59). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the rights protection system of Ginter et al. into the rights protection system of Shear et al. as modified by Downs et al. and Ginter et al. in order to lessen the time during which each key is used, giving an attacker less ciphertext to use in an attempt to obtain the key (Column 212, lines 43-52).

Regarding Claim 4,

Shear et al. and Downs et al. do not disclose that the previous key is destroyed after it is changed.

Ginter et al. disclose that the previous key is destroyed after the change of the key (Column 214, lines 4-14). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the rights protection system of Ginter et al. into the rights protection system of Shear et al. as modified by Downs et al. and Ginter et al. in order to lessen the time during which each key is used, giving an

attacker less ciphertext to use in an attempt to obtain the key (Column 212, lines 43-52).

Regarding Claim 5,

Shear et al. disclose that the hidden channel is arranged to be not accessible by commercial reproducing devices (Page 15, Paragraph 218).

Regarding Claim 6,

Shear et al. disclose that the hidden channel is generated by storing the hidden information in deliberate errors which can be corrected again or in a memory embedded with a disc controller (Page 15, Paragraph 218).

Regarding Claim 7,

Shear et al. disclose that the attached usage right information is stored in a table together with a key information used for decrypting the DW (Page 15, Paragraph 216).

Regarding Claim 8,

Shear et al. disclose that the DW is an audio track downloaded from the Internet, and the record carrier is a recordable optical disc, a hard disc, a magneto-optic recording device, a magnetic tape, or a memory card (Page 12, Paragraph 178).

Regarding Claim 9,

Shear et al. and Ginter et al. do not disclose that the usage right information comprises a counter information which can be updated when the right has been exercised.

Downs et al., however, disclose that the usage right information comprises a counter information which can be updated when the usage right has been exercised (Column 21, lines 42-63). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the content delivery system of Downs et al. into the rights protection system of Shear et al. as modified by Downs et al. and Ginter et al. in order to enforce the usage rights on the original copy and any new secondary copy.

Regarding Claim 10,

Shear et al. disclose that the record carrier has tracks, and each track comprises its own usage right information and hidden information (Page 13, Paragraph 183).

Regarding Claim 12,

Shear et al. disclose that the record carrier is a recordable optical disc, in particular a CD or a DVD (Page 11, Paragraph 162).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shear et al. in view of Downs et al. and Ginter et al., further in view of Smithies et al. (U.S. Patent 6,064,751).

Shear et al. as modified by Downs et al. and Ginter et al. does not disclose a checksum.

Smithies et al., however, disclose that the hidden information is a checksum over a data block containing the information (Column 13, lines 51-63). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the checksum technique of Smithies et al. into the rights protection system of Shear et al. as modified by Downs et al. and Ginter et al. in order to ensure that the data was not decrypted, modified, and re-encrypted, thus maintaining integrity.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER